

## **REMARKS**

### **Withdrawal of the Finality**

Page 1 of the Office Action issued June 10, 2009 indicates that the Office Action is Final, however, the body of the Office Action provides no explanation as to why the Action is said to be Final.

It is believe that making of the Office Action Final was an error. But, in any event, applicants request withdrawal of the Finality of the Action.

In the Final Office Action, claims 5 and 28 were rejected under 35 USC 112, second paragraph. Claims 1, 2, 4-18, and 21-27 were rejected as being anticipated in view of Schmitz et al. (US 6,794,048). Claim 3 was rejected under 35 USC 103(a) in view of Schmitz et al. (US 6,794,048).

With the RCE filed March 20, 2009, applicants filed an amendment wherein claim 1 was amended to recite that in polymeric layer (2) the polymer “comprises” a graft copolymer having polyamide blocks, and to recite that the average number of moles of unsaturated monomer X attached to the polyolefin backbone is 1.3 to 7 moles per mole of chain. In addition, new claims 29-37 were added. New claim 29 recited that in polymeric layer (2) the polymer consisted of the graft copolymer having polyamide blocks, as was recited in the prior version of claim 1.

In the June 10, 2009 Office Action, several new grounds of rejection are made. These new rejections are based on art not previously of record and on grounds not previously presented.

An action immediately subsequent to the filing of a RCE with a submission may be made final only if the conditions set forth in MPEP 706.07(b) for making a first action final in a continuing application are met. One of the requirements set forth in MPEP 706.07(b) is that the claims would have been properly finally rejected on the grounds and art of record if they had been entered in the application prior to the filing of the RCE. In the instant case, it is evident that the claims could not have been finally rejected on the grounds and art that were of record before the filing of the RCE as several clams are rejected only on the new grounds/new art presented for the first time in the June 10, 2009 Office Action.

In view of the above remarks, withdrawal of the finality of the June 10, 2009 Office

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Action is respectfully requested.

### **Amendments**

Claim 1 is amended to incorporate the feature of claim 29 (now cancelled). Thus, claim 1 is amended to recite that in polymeric layer (2) the polymer “consists of” a graft copolymer having polyamide blocks. This amendment does not require further significant search and/or consideration as the feature of claim 29 has already been considered by the Examiner. Additionally, this feature was previously recited in claim 1 prior to the issuance of the Final Office Action of April 18, 2008 and the filing of the RCE of March 20, 2009.

Similarly, claims 34 and 36 are amended to incorporate the features of claims 35 and 37, respectively (now cancelled). As a result, claims 34 and 36 also now recite that in polymeric layer (2) the polymer “consists of” a graft copolymer having polyamide blocks.

In addition, claims 1, 34, and 36 are amended to further clarify the polyamide having an amine end group. Claim 28 is amended to be consistent with the disclosure at page 19, lines 6-8.

These amendments do not require further significant search and/or consideration. Also, the amendments reduce the number of issues for appeal by rendering moot at least some of the rejections. Entry of the amendments is respectfully requested.

### **Objection to the Specification**

The specification is amended to correct the obvious typographical error at page 18, line 15, as suggested by the Examiner. Withdrawal of the objection is respectfully requested.

### **Double Patenting**

Claims 1, 34, and 36 are rejected as allegedly being obvious in view of claim 21 of Court et al. (US 6,875,520). This rejection was not applied against claims 29, 35, and 37. As noted above, claims 1, 34, and 36 are amended above to incorporate the recitations of claims 29, 35, and 37, respectively. Thus, the amendments to claims 1, 34, and 36 render this rejection moot.

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**Rejection under 35 USC 112, second paragraph**

Claims 30, 33, and 34 are rejected as being indefinite. This rejection is respectfully traversed.

In the rejection, it is asserted that the recitation of “said polyamide” in claims 30, 33, and 34 is indefinite because there are two polyamides recited previously. However, these claims refer to “said polyamide having an amine end group.” This particular polyamide has clear antecedent basis and thus is not indefinite.

However, in order to facilitate prosecution, the claims are amended to further clarify which polyamide is being referred to in the objected to language. Withdrawal of the rejection is respectfully requested.

**Rejection of claims 1, 5, 28, 34, and 36 under 35 USC 102(e) in view of Court et al.**

Claims 1, 5, 28, 34, and 36 are rejected as allegedly being anticipated in view of Court et al. (US 6,875,520). This rejection was not applied against claims 29, 35, and 37. As noted above, claims 1, 34, and 36 are amended above to incorporate the recitations of claims 29, 35, and 37, respectively. Thus, the amendments to claims 1, 34, and 36 render this rejection moot.

**Rejection under 35 USC 102(e) in view of Schmitz et al. and Rejection under 35 USC 103(a) in view of Schmitz et al.**

Claims 36-37 are rejected as being anticipated in view of Schmitz et al. (US 6,794,048) “as evidenced by” Court et al. (US 6,875,520). Additionally, claims 1-4, 6-8, 10-18, 21, 22, and 24-35 are rejected as being obvious in view of Schmitz et al. (US 6,794,048). These rejections are respectfully traversed.

It is evident from the Office Action that the Examiner and the applicants disagree about the disclosure of Schmitz et al. (US 6,794,048). However, as discussed in more detail below, even under the Examiner’s interpretation, the Schmitz et al. disclosure does not anticipate or render obvious applicants’ claim 36, or any of applicants’ other claims.

Schmitz et al. (US 6,794,048) disclose a multilayer composite that comprises a

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polyamide layer and a polyolefin layer. These layers are joined by a bonding layer which does not consist of a functionalized polyolefin. The generic description of the multilayer composite of the Schmitz et al. invention comprises (see column 1, line 40 - column 2, line 2):

- (I) a layer I of a polyamide molding composition;
- (II) (II) a layer II of a bonding agent comprising at least 50% by weight, of a **mixture** of a) from 30 to 70 parts by volume of polyamide, and b) from 70 to 30 parts by volume of polyolefin, the sum of the parts by volume being 100, **wherein at least some of the polyamide is present in the form of a polyamide-polyolefin graft copolymer** or as a highly branched polyamine-polyamide copolymer; and optionally
- (III) a layer of a polyolefin molding composition. I

As noted, this is the general description of the Schmitz et al. invention. After this description, Schmitz et al. describe several “preferred embodiments” of the invention, the implication being that these preferred embodiments fall within the description of the general invention.

At column 1, line 40 - column 2, line 2, the bonding agent layer (II) of the composite is described as comprising at least 50 wt. % of a mixture of polyamide and polyolefin. Reference to this mixture can be found throughout the disclosure. See, e.g., column 3, lines 6-12.

In the Office Action, it is argued that this mixture may contain a constituent which is in the form of polyamide-polyolefin graft copolymer, as described at, for example, column 1, lines 63-67 and column 3, lines 7-47. Further, Schmitz et al. specifically discloses at column 1, lines 40-43 that the bonding layer does not consist of a functionalized polyolefin. Thus, layer II of the multilayer structure composite of Schmitz et al. contains a mixture of polyamide and polyolefin polymers, wherein the mixture may further contain polyamide-polyolefin graft copolymer.

In the rejection, it is argued that all of the polyamide of the mixture can be present in the form of graft copolymer. See page 5, lines 4-6 of the Office Action. This argument is based on the interpretation that “at least some” reads on “all.” However, this interpretation

does not suggest that the “mixture” described by Schmitz et al. consists of polyamide-polyolefin graft copolymer.

The language at column 1, lines 61-67 states that at least some of the polyamide is present in the form of a polyamide-polyolefin graft copolymer or as a highly branched polyamine-polyamide copolymer. But, even if interpreted to mean that all of the polyamide is present in the form of a polyamide-polyolefin graft copolymer, the language does not indicate that all of the polyolefin will also be in the form of the polyamide-polyolefin graft copolymer, nor does it suggest such an embodiment. This is consistent with the “mixture” language.

A mixture of polyamide, all of which is present in the form of a polyamide-polyolefin graft copolymer, and polyolefin is still a “mixture.” However, the argument that the disclosure of Schmitz et al. encompasses such a “mixture” does not support an assertion that layer II of the multilayer structure composite of Schmitz et al. consists of polyamide-polyolefin graft copolymer. Compare claim 36.

In the Office Action, it is argued that the “composition” disclosed by Schmitz et al. at column 3, lines 7-35 is a graft copolymer. Applicants disagree. The disclosure at column 3, lines 7-10 clearly refers to a mixture. Similarly, the disclosure at column 3, lines 11-15 also refers to a mixture in which at least parts of the constituents are in the form of a polyamide-polyolefin graft copolymer. This should be read to be consistent with the generic description at column 1, lines 51-67, i.e., that at least some of the polyamide can be in the form of a polyamide-polyolefin graft copolymer. As for the disclosure at column 3, lines 15-37, this is a description of preparing a graft copolymer. But, describing how to make a graft copolymer is not inconsistent with there being a “mixture” present. Nor does this description suggest that “mixture” means reacted together, as suggested in the Office Action.

With respect to the disclosure at column 3, lines 38-47, to read this disclosure so as to encompass an embodiment wherein all of the polyamide component and all of the polyolefin component are together present solely in the form a polyamide-polyolefin graft copolymer would require one to read the disclosure in a manner that is inconsistent with the general description of the “mixture” at column 1, lines 55-67.

Furthermore, even if one were to argue that the disclosure of Schmitz et al. generically encompasses an embodiment wherein layer II consists of polyamide-polyolefin graft copolymer, the mere disclosure of a genus does not establish anticipation of every

embodiment encompassed therein. It is noted that neither of the two Examples of Schmitz et al. describe such an embodiment. In fact, the two examples of Schmitz et al. involve embodiments wherein at least some of the polyamide is present in the form of a highly branched polyamine-polyamide copolymer. They do not involve embodiments where any of the polyamide is present in the form of a polyamide-polyolefin graft copolymer.

Compare, for example, *In re Ruschig et al.*, 145 USPQ 274 (CCPA 1965), wherein the Court distinguished a prior decision, *In re Petering et al.* in which the Court had found anticipation. In *Petering*, the Court held the at prior art genus of 20 compounds was sufficiently small that one of ordinary skill in the art could envision each member of the limited genus. Thus, the genus was said to anticipate each of the 20 compounds.

However, in *Ruschig*, the Court in distinguishing *Petering* stated:

We did not intend our *Petering* decision to become a precedent for mechanistic dissection and recombination of the components of the specific illustrative compounds in every chemical reference containing them, to create hindsight anticipations with the guidance of applicants' disclosures, on the theory that such reconstructed disclosures describe specific compounds within the meaning of section 102.

Thereafter, the Court held prior art genera encompassing 130, 156, and 259 compounds did not establish anticipation.

In the instant situation, even if the disclosure is interpreted in the manner suggested by the Examiner, the generic disclosure is too broad to "describe" an anticipatory embodiment in accordance with 35 USC 102. There is no specific embodiment disclosed by Schmitz et al. that suggests, let alone anticipates, applicants' claimed invention. As noted, the two specific embodiments disclosed in the Examples clearly do not suggest applicants' claimed invention. There is no suggestion within the generic description of Schmitz et al. that, in light of all the numerous possible embodiments, would lead one to an embodiment in accordance with applicants' claims 1, 34, or 36.

In the anticipation rejection, the disclosure of Court (US '520) (commonly assigned with the instant application) is relied on for a teaching of polyamide-block graft copolymers that have a nanostructured organization with polyamide lamellae having a thickness of between 10 and 50 nanometers. See column 8, lines 1-4. It is further noted that Court et al. disclose that the polyolefins used in preparing the polyamide-block graft copolymers can have

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on average from 1.3 to 7 mol of X (residues of the unsaturated monomer) per chain attached to the polyolefin backbone. See column 6, lines 47-51. Court et al. also disclose and that the amine-terminated polyamide used in preparing the polyamide-block graft copolymers has a molar mass of between 1000 and 5000 g/mol. See column 7, lines 30-32.

In the rejection, it is asserted that polyolefin-polyamide graft copolymer of Schmitz et al. will also have the structure described by Court et al. (i.e., nanostructured organization with polyamide lamellae having a thickness of between 10 and 50 nanometers) because the polyolefin-polyamide graft copolymer of Schmitz et al. is “produced in the same way.”

The disclosure of Court et al. does not demonstrate how Schmitz et al.’s generic disclosure would anticipate applicants’ claimed invention under 35 USC 102. Such a generic disclosure in the absence of any direction pointing towards the claimed invention is not a fair suggestion of the invention and it is not sufficient to establish anticipation under 35 U.S.C. §102. Schmitz et al. does not disclose an embodiment that “describes” applicant’s claimed invention in accordance with 35 U.S.C. §102.

In addition, the mere disclosure of a broad genus also does not render obvious each and every embodiment encompassed therein. See, for example, the non-precedential opinion issued by the Board in *Ex parte Rozzi*, 63 USPQ2d 1196, 1201 (Bd. of Pat. Appls. & Interf. 2002), where the Board, in reversing an obviousness rejection stated:

The Examiner does not make out a case of obviousness merely by virtue of the fact that the subject matter of a rejected claim is, to use the examiner’s words, ‘generically’ described by the prior art.

The number of embodiments encompassed by the generic disclosure of Schmitz et al. is quite numerous. The rejection relies on an interpretation of the reference that is asserted to encompass an embodiment of applicants’ invention. Yet, even if interpreted in this manner, the rejection does not provide sufficient rationale as to why one would select this particular embodiment from all of the other numerous embodiments, particularly when the Examples and particularly preferred embodiments of the Schmitz et al. disclosure point one in a completely different direction, i.e., towards embodiments wherein at least some of the polyamide is present in the form of a highly branched polyamine-polyamide copolymer.

In view of the above remarks, it is respectfully submitted that the disclosure of Schmitz et al. fails to anticipate and/or render obvious applicants claimed invention.

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Withdrawal of the rejections is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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